

**Application No.:** 10/728,509  
**Filing Date:** December 5, 2003

### REMARKS

Applicants thank the Examiner for her review of the pending claims. Applicants have amended claims 1, 2 and 13 for clarity. For the reasons stated below, Applicants respectfully traverse the rejections of the pending claims.

#### 35 U.S.C. §§ 102(e) – Anticipation

The Examiner rejects claims 1, 2, 11, and 13 under 35 U.S.C. § 102(e) as anticipated by Baxter et al. (WO 03/006029). Applicants respectfully traverse.

The international filing date listed on the face of WO 03/006029 is July 15, 2002. The reference claims priority to an Australian application PR 6331 filed on July 13, 2001. Because the priority document is a foreign application, the 102(e) date of WO 03/006029 is apparently July 15, 2002. *See M.P.E.P. § 2136.03* (“Foreign applications’ filing dates that are claimed ... in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as U.S.C. 102(e) dates for prior art purposes.”) (emphasis in original).

The instant application is a continuation of and claims priority from U.S. Serial No. 09/908,147 filed July 17, 2001. Because the priority date of the instant application is prior to the 102(e) filing date of WO 03/006029, July 15, 2002, WO 03/006029 is not available as prior art under 35 U.S.C. § 102(e). Applicants therefore request reconsideration and withdrawal of the rejection of the pending claims under 35 U.S.C. § 102(e) over WO 03/006029.

#### 35 U.S.C. §103(a) – Obviousness

The Examiner rejects claims 1-9, 11-14, 17 and 18 under 35 U.S.C. § 103(a) as unpatentable over Baxter et al. (WO 03/006029) as applied in the 35 U.S.C. § 102(e) rejection above, in view of Korsmeyer, Milner *et al.* and McKay *et al.* The Examiner relies upon WO 03/006029 as discussed above in the 102(e) rejection, but states that WO 03/006029 does not disclose various features of the claims such as specific chemistries. The Examiner relies on the secondary references to supply the subject matter missing from WO 03/006029. *Office Action* at 5-6.

As discussed above, the 35 U.S.C. § 102(e) date of WO 03/006029 is July 15, 2002, which is after the priority date of the instant application, July 17, 2001, and therefore WO

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03/006029 is not available as prior art under 35 U.S.C. § 102(e). In addition, WO 03/006029 was published on January 23, 2003, and therefore WO 03/006029 is not available under 35 U.S.C. §§ 102(a) or (b). Therefore, WO 03/006029 is not available as prior art under 35 U.S.C. § 103(a).

In the absence of the disclosure of the primary reference WO 03/006029, the Examiner has failed to establish a prima facie case of obviousness. Applicants respectfully request that the Examiner withdraw the rejection of the pending claims under 35 U.S.C. § 103(a) over WO 03/006029 in view of Korsmeyer, Milner *et al.* and McKay *et al.*

#### No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

#### Patents and Applications

Applicants wish to draw the Examiner's attention to the following patent(s) or application(s). Applicants encourage the Examiner to review and monitor the prosecution of the following patent(s) and/or application(s) throughout the pendency of this application.

Patent/Serial No.	Title	Issued/Filed
09/908,147	Antisense modulation of BCL2-associated X protein expression	07-17-2001

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### CONCLUSION

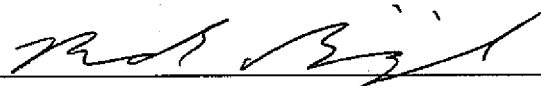
In view of the above, Applicants respectfully maintain that claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 10/15/08

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